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10/055,313	01/23/2002	Chad Stevens	10013604-01	8004

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER OSORIO, RICARDO

ART UNIT 2673	PAPER NUMBER
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DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,313

Applicant(s)

STEVENS ET AL.

Examiner

RICARDO L OSORIO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12202004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,9,10 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

DRAWINGS

1. After considering applicant's arguments filed on December 20, 2004 regarding the objection to the drawings in the previous office action, examiner is persuaded that the user interface device in Fig. 1, reference character 120, together with page 13, lines 22-25, of the specification, provide sufficient support for "user interface device for enabling the electronic paper display to present a user with a plurality of reference images grouped for display on the electronic paper display device". Therefore, the objection to the drawings is withdrawn.

2. As noted by applicant, examiner inadvertently omitted claims 22, 23 and 25 from paragraph 2, on page 3 of the previous office action. However, on page 5, line 4, claims 22, 23 and 25 are being mentioned and, as admitted by applicant, arguments rejecting the claims are being provided. Clarification will be provided below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-4, 9, 10, 13, 16, 18, 19, 21, 22, 23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Comiskey 6,473,072).

Regarding claim 1, Comiskey teaches of a whiteboard apparatus (Fig. 12a, reference character 120, and col. 14, lines 50-53) comprising:

an electronic paper display device (col. 13, lines 58-61); a writing surface (Fig. 12b, reference character 129) arranged in superimposed relationship with the electronic paper display device (col. 14, lines 47-49 and 52-53. Note that the protecting layer or coating is the superimposed writing surface); and a user interface device (col. 16, lines 60-68) for enabling the electronic paper display to present a user with a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-64. Any underlying image over which the user may write constitutes a reference image) grouped for display on the electronic paper display device (col. 16, lines 60-64) to assist the user in drawing on the writing surface over a selected one of the plurality of reference images (col. 14, lines 47-61 and col. 16, lines 48-68). Examiner understands that an image comprised by an interactive series of images being downloaded and displayed on the drawing screen is, or at least requires, a user interface device. Further, considering that the interactive series of images are being grouped for display on a **drawing screen**, it is clear that when the user selects one of said interactive images, this image is a reference image that assist the user in drawing upon it. Although the term user interface device is not specifically mentioned, by definition, an image comprised by an interactive series of images is used by the user to select one of said series of interactive images on which the user has particular interest, for example, JPEG images, GIF images, etc. Therefore, it is inherent for Comiskey to have a user interface device.

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Regarding claim 2, Comiskey teaches of the electronic paper display device comprising: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

Regarding claim 3, Comiskey teaches that the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 4, Comiskey further teaches of a network interface device configured for communication with a communication network and wherein the image displayed on the electronic paper display is received via the communication network (col. 16, lines 48-52 and 60-67. Note that the communications device and appropriate logic circuitry used to download information from the web or, internet, requires a network interface).

Regarding claim 9, Comiskey further teaches of a scanning device configured to convert a document to an electronic image to be displayed on the electronic paper display device (col. 17, lines 2-6).

Regarding claim 10, further (see claim 1) Comiskey teaches of a method comprising the steps of providing an electronic paper display device (col. 13, lines 58-61); arranging a writing surface (Fig. 12b, reference character 129) in superimposed relationship with the electronic paper display device (col. 14, lines 47-61. Note that the protecting layer or coating is the superimposed

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writing surface); displaying on the electronic paper display device a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-68. Any underlying image over which the user may write constitutes a reference image and a predefined image); and furthermore enabling a user to select a predefined image from the plurality of reference images for display on the electronic paper display device (col. 16, lines 60-68), where the predefined image (any underlying image over which the user may write constitutes a reference and a predefined image) assists the user in drawing on the writing surface over the predefined image displayed by the electronic paper display (col. 14, lines 47-61 and col. 16, lines 48-68). The arguments regarding claim 1 above are also applicable to claim 10.

Regarding claim 13, Comiskey further teaches than the electronic paper display employs electronic ink technology (col. 5, line 45).

Regarding claim 16, Comiskey further teaches of scanning the image from a document (col. 17, lines 2-3).

Regarding claim 18, Comiskey further teaches that the electronic display device comprises: a plurality of image elements, each of the image elements having one or more charged particles (Fig. 1a, reference character 16, and col. 6, lines 36-39. Note that each one of the needle-like particles is an image element); and logic configured to display the image by controlling the orientation of the charged particles (col. 6, lines 39-45).

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Regarding claim 19, Comiskey, further, teaches (see claim 1) of a memory configured to store the plurality of reference images to be displayed on the electronic paper display device (see Comiskey, col. 16, lines 49-50 and col. 17, lines 2-6. A plurality of images are recalled from memory, or displayed).

Regarding claim 21, Comiskey, further, teaches (see claim 10) that the user interface device includes a graphical user interface displayed on the electronic paper (col. 16, lines 60-64) to enable a user to view and select from the electronic paper a predefined image (col. 14, lines 47-53 and col. 16, lines 60-64. Any underlying image over which the user may write constitutes a reference image and a predefined image) of the plurality of reference images stored in the memory (col. 16, lines 49-50 and col. 17, lines 2-6). Examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Although the term graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images is used by the user to select one of said series of interactive images on which the user has particular interest. Therefore, it is inherent for Comiskey to have a graphical user interface.

Regarding claim 22, Comiskey further teaches (see claim 10) of selecting the predefined image to be displayed on the electronic paper display device from a plurality of reference images (col. 14, lines 47-61 and col. 16, lines 60-68. Any underlying image over which the user may

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write constitutes a reference, or predefined, image) displayed on the electronic paper display (col. 16, lines 60-64).

Regarding claim 23, Comiskey further teaches (see claim 10) of downloading the predefined image to be displayed on the electronic paper display device (col. 16, line 60-68).

Regarding claim 25, Comiskey further teaches (see claim 10) of selecting the predefined image from a graphical user interface displaying the plurality of reference images (see col. 16, lines 60-68). Again, examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Although the term graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images (emphasis added) is used by the user to select one of said series of interactive images on which the user has particular interest, for example JPEG images, GIF images, etc. In conclusion, it is inherent for Comiskey to have a graphical user interface.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey.

Regarding claims 20 and 24, Comiskey does not precisely teach of hardware buttons corresponding to a predetermined image of the plurality of reference images stored in the memory.

However, Comiskey teaches of recalling images from memory and of downloading a series of interactive images (see col. 16, line 60-col. 17, line 6). To recall images from either a local memory device, or a server, software buttons (options) needs to be selected.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have either the hardware buttons, or software buttons, in the device of Comiskey because it is a well known choice of the user or manufacturer of the system to have software buttons, hardware buttons, or a combination of both, wherein the same result is obtained and one type of button can be substituted for the other.

7. Claims 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey et al. (6,473,072) in view Chery et al (6,177,927).

Regarding claims 5, 14 and 15, Comiskey fails to teach that the reference, or predefined, image comprises a Cartesian plane, or a template of a flowchart.

Chery teaches of a reference image comprising a Cartesian plane, or a template of a flowchart: Chery teaches of a large variety of background, or reference, or predefined, images over which a user may write on the writing surface which may include a spreadsheet, blueprints, text, graphs, graphics (see Chery, col. 24, lines 30-50). Also, Chery teaches that images for the background

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images can be created with graphics programs such as VISIO, CAD programs, or other programs used to make documents, and also, that the reference image can be an image from a webpage (see Chery, col. 24, line 62-col. 25, line 5, and col. 25, lines 33-43). Finally, Chery teaches of a Cartesian coordinate that is transposed on the writing surface; the corners of the monitor image area are defined as (0,0), (0,H), (W,0) and (W,H) (see Chery, Figs. 11B and 11C, and col. 49, lines 47-63)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a reference image showing a Cartesian plane, or template, as taught by Chery, in the device of Comiskey, so that the user can write a stroke on the writing surface and know the precise stylus location (see Chery, col. 49, line 66-col. 50, line 2). Also, it is well known in the art of graphics that a program such as CAD can be used to create any desired graphical image such as a Cartesian coordinate, a graph, flowchart, etc.

8. Claim 17 and 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Comiskey (see above) in view of applicant's admitted prior art (APA, hereafter).

Regarding claim 17 and 26, Comiskey fails to teach of printing the image displayed on the electronic paper display and the contents of the writing surface.

APA teaches of printing the combined scan result of the predefined image displayed on the electronic paper display and the contents of the writing surface (see application, page 2, lines 2-5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the combined image, as taught by APA, in the device of Comiskey because it is well known in the art of electronic whiteboards to integrate a printer which can print both

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original images and updated images, for example, to provide an updated hard copy of the lecture or conference to all the participants.

Response to Arguments

9. Applicant's arguments filed 12-20-2004 have been fully considered but they are not persuasive.

Regarding independent claims 1 and 10, applicant provided the following arguments:

First, applicant states that the examiner cited col. 14, lines 47-53 and col. 16, lines 48-68 as describing a “user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image”. Further, applicant notes that the above quoted language is not a claim element in either independent claims 1 or 10.

Examiner disagrees because the quoted language is not the only language used by the examiner in the rejection of claims 1 and 10. Although examiner considers said language to be equivalent to the claim language, the language that follows said quotation is even more specific than the language of claims 1 and 10, or applicant's quoted language. In general, even if not the same wording, or an exact copy of the claims, is provided in the rejection, all the limitations of claims 1 and 10 are being addressed. **Furthermore, applicant does not specifically point out which limitations are not being addressed by the examiner.** Although all the limitations were

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addressed in the previous office action, for clarification purposes, examiner has addressed, in this office action, claims 1, 19, 21-23 and 25 separately (see above rejection).

Next, applicant argues that examiner cited the same portions of the Comiskey reference as describing displaying on the electronic paper display device a plurality of reference images, and enabling a user to select a predefined image from the plurality of reference images for display on the electronic paper display device, where the predefined image assists the user in drawing on the writing surface over the predefined image displayed by the electronic paper display.

Examiner in response states that as long as the portions of the Comiskey reference used by the examiner read on all the limitations of claims 1 and 10, the same portions can be used. The issue is whether the citations of Comiskey used by the examiner teach or not all the limitations of claims 1 and 10. **Again, applicant does not specifically point out which limitations are not being addressed.**

Next, applicant argues that the Comiskey reference does not teach a white board apparatus having an electronic paper display device, a writing surface, and a user interface.

Examiner disagrees because Comiskey clearly teaches a whiteboard apparatus (see Fig. 12a, reference character 120, and col. 14, lines 50-52) having an electronic paper display device (see Fig. 12b, reference character 127, col. 13, lines 30-43 and 58-61, and col. 14, lines 45), a writing surface (see Fig. 12b, reference character 129, and col. 14, lines 47-53), and a user interface (see col. 16, lines 48-68 and col. 17, lines 2-6. Specifically, col. 16, lines 60-68, discloses a display allowing a user to download and display an image on the drawing screen, the image can be an image from a database, which requires the user to select said image from a database so that it can be displayed (user interface). Also, specifically, col. 17, lines 2-6, when used in combination

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with a data storage device or memory device, or communications device, the drawing system is allowed to store and recall images, and recalling images from a storage or memory device requires the user to select a specific image or file (user interface). Furthermore, and even more clearly, specifically in col. 16, lines 60-68, the downloaded and displayed image can be “even an **interactive series of images**”. Examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Although the term graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images is used by the user to select one of said series of interactive images on which the user has particular interest, for example, JPEG images, GIF images, etc. Therefore, it is inherent for Comiskey to have a graphical user interface.

Finally, applicant argues that the Comiskey reference does not appear to teach the claimed features of presenting a user with a plurality of reference images grouped for display on the electronic paper display device and the selection of one for placement on the display device on which a user will draw upon it.

Examiner disagrees because, further, and as mentioned in the previous arguments, and in specific reference to col. 16, lines 60-68, the downloaded and displayed image can be “even an **interactive series of images**”. Examiner understands that an image comprised by an interactive series of images (emphasis added) being downloaded and displayed on the drawing screen is, or at least requires, a graphical user interface. Considering that the interactive series of images are being grouped for display on a **drawing screen**, it is clear that the user selects one of said interactive images as the reference, or predefined image to draw upon it. Although the term

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graphical user interface is not specifically mentioned, by definition, an image comprised by an interactive series of images (emphasis added) is used by the user to select one of said series of interactive images on which the user has particular interest, for example JPEG images, GIF images, etc. In conclusion, it is inherent for Comiskey to have a graphical user interface for selection of one of a plurality of reference images for placement on the display device on which a user will draw upon it.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 703 305-2248. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30

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P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 703 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

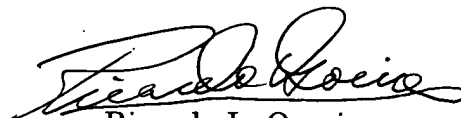
Washington, D.C. 20231

or faxed to:

703 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Ricardo L. Osorio
Examiner
Art Unit: 2673

RLO
January 25, 2005